

REMARKS

The Office Action dated June 29, 2006 has been carefully reviewed and considered. Claims 17, 21-31 are currently pending and Claims 17, 21-25 and 28-30 stand rejected.

In the foregoing Amendments, Claims 17, 21, 24, 27-29 and 31 have been amended and Claims 32-40 have been added. Support for these amendments can be found in the specification and claims of the application as filed. No new matter has been added. Claim 26 has been canceled without prejudice or disclaimer of the subject matter contained therein. Claims 17, 21-25, 27-40 are currently pending.

Applicants thank the Examiner for considering the amendments and remarks in Applicants' response mailed on June 9, 2006, and for indicating allowable subject matter of Claims 26-27 and 31 if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Accordingly, Claim 21, which incorporates allowable Claim 26, Claim 27 and 31 have been amended to explicitly incorporate all of the limitations of the base claim and intervening claims, and therefore are in the condition for allowance.

Applicants respectfully request entry of the foregoing Amendments and reconsideration of the present application in light of the amendments above and the remarks below.

Objection over Claiming Priority

The Office Action objects the present application under the first paragraph of 35 U.S.C. 112 alleging that the present invention can not claim the priority date of September 4, 1997 from a parent US patent application no. 08/923,477 (US6,106,301), hereinafter referred to the '477 application, because the disclosure of the '477 application bears no mention of, among other features, the retainer and ring configuration or of a pivotable mock anatomical site. (See pages 2-3 of the Office Action.) Applicants respectfully disagree with this objection because the '477 application provides adequate support for the presently claimed invention. However, to expedite

the allowance of the present application, Applicants add Claims 38-40, which recite features specifically supported and/or disclosed by the '477 application. Accordingly, this §112 objection is obviated.

The 35 U.S.C. §112 Rejection

Claims 17 and 28-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Office Action alleges that the claimed subject matter, such as the phrase “coupled to and spaced apart from,” is not precisely described. (See page 3 of the Office Action.) Applicants submit herein proposed amendments to claims 17, 28 and 29, which, as amended, are believed to comply with the enablement requirement. Accordingly, claims 17, 28-29 are now in condition for allowance.

The 35 U.S.C. § 103 Rejection

Claims 21-25 and 30 are rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Martin et al. (US Patent No. 5,828,197), hereinafter referred to “Martin”, in view of Lang et al. (US Patent No. 5,480,307), hereinafter referred to “Lang.” Without admitting that Martin and Lang are prior art and reserving the right to establish that they are not prior art, Applicants respectfully disagree with this rejection.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed

combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.¹

In order to expedite the allowance of the present application, Applicants have amended independent claims to further particularly point out and distinctly claim subject matter regarded as the invention. For example, amended Claim 21 of the present invention recites in part:

wherein the inserting a peripheral device further includes:
passing the peripheral device through a first retainer, which is substantially fixed
to a first ring, and
guiding the peripheral device through a second retainer, which is substantially
affixed to a second ring.

(Emphasis added). In contrast, neither Martin nor Lang nor a combination of both discloses or teaches a first retainer, which affixes to a first ring, and a second retainer, which affixes to a second ring.

A desired outcome that the invention provides cannot be used as the motivation to combine the references if there is no such teaching in the references. Since neither Martin nor Lang teaches or suggests a combination between Martin and Lang, Applicants contend that there is no teaching to combine.

Even assuming for the sake of argument that Martin and Lang were combined, the combination would still fail to render the present invention obvious because neither Martin nor Lang nor a combination of both discloses or suggests a simulation technique of a first retainer affixing to a first ring and a second retainer affixing to a second ring. Accordingly, one of ordinary skill in the art would not combine Martin and Lang, because even if they were combined, the combination would still fail to disclose or suggest each and every element disclosed in Claim 21. At least for the reasons stated above, Claim 21 is patentable over Martin in view of Lang under §103.

¹ M.P.E.P § 2143.

If the independent claims are valid, the claims that depend from the independent claims should also be valid as matter of law. See Jenric/Pentron, Inc. v. Dillon Co., 205 F. 3d 1377, 1382 (Fed. Cir. 2000).). Since Claims 22-23 depend on allowable independent Claim 21, Claims 22-23 should also be patentable as matter of law.

Claim 24 has been amended to incorporate the allowable subject matter recited in Claim 26. As such, amended Claim 24 is in condition for allowance. Since Claim 30 depends on Claim 24, Claim 30 should also be allowable as matter of law.

Conclusion

Based on all of the above, Applicants believe all claims now pending in the present application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

No additional fees are believed to be due at this time. However, please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

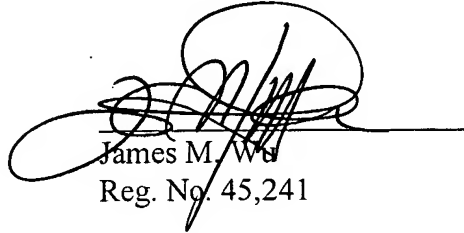
Applicants thank the Examiner for carefully examining the present application and if a telephone conference would facilitate the prosecution of this application, the Examiner is invited to contact Jim Wu at (408) 282-1885.

Respectfully submitted,

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Dated: _____

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